CUSTOMER NO.: 24498
Serial No.: 10/510,605
Date of Office Action: 07/28/09
Response dated: 10/30/09

PATENT
PU020102

Remarks/Arguments

In the Non-Final Office Action dated July 28, 2009, it is noted that claims 3-9 and 12-21 are pending in this application; and that all the claims stand rejected under 35 U.S.C. §103.

By this response, claims 3 and 12 have been amended to incorporate all the limitations of claims 8-9 and claims 17-18, respectively. Claims 6-9 and 15-18 have been cancelled without prejudice. The amendments to these claims are believed to be proper and justified. No new matter has entered.

Examiner Interview

Applicant's representative thanks the Examiner for the courtesy extended during the recent telephone interview conducted on October 8, 2009. The interview was precipitated by an apparent discrepancy in the current Office Action.

In the Office Action Summary of the present action, the Examiner had indicated that the Office Action was Non-Final. However, on page 12 of the same Office Action, the Examiner indicated in bold print that the action was made FINAL.

The discussion during the interview covered these issues. The Examiner rectified the discrepancy by stating that the action was intended to be non-final, and would be considered as such for the purposes of this response. The Examiner decided that it would not be necessary to issue a new Office Action or to prepare and mail an Examiner Interview Summary.

Cited Art

The following references have been cited and applied in the present Office Action: U.S. Patent Application Publication No. 2003/0227567 to Plotnick et al. (hereinafter referenced as "*Plotnick*"); U.S. Patent Application Publication No. 2002/0100041 to Rosenberg et al. (hereinafter referenced as "*Rosenberg*"); U.S. Patent 7,061,549 to Mabon (hereinafter referenced as "*Mabon*"); U.S. Patent 6,002,443 to Iggulden (hereinafter referenced as "*Iggulden*"); U.S. Patent Application Publication No. 2002/0194595 to Miller et al. (hereinafter referenced as "*Miller*"); U.S. Patent 6,698,020 to Zigmond (hereinafter "*Zigmond*"); U.S. Patent Application Publication No. 2005/0149981 to Augenbraun et al. (hereinafter referenced as "*Augenbraun*");

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U.S. Patent Application Publication No. 2002/0144262 to Plotnick et al. (hereinafter referenced as "*Plotnick II*"); and U.S. Patent Application Publication No. 2002/0056107 to Schlack (hereinafter referenced as "*Schlack*").

Rejection of Claims 3-5, 8, 12-14, and 17 under 35 U.S.C. §103

Claims 3-5, 8, 12-14, and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg and further in view of Mabon, and further in view of Iggulden. Claims 8 and 17 have been cancelled and their limitations have been incorporated into their respective base independent claims. This rejection is respectfully traversed.

As noted above, claim 3 has been amended to include the limitations of both claim 8 and claim 9, while claim 12 has been amended to include the limitations of both claim 17 and claim 18. Since these limitations are now present in claims 3 and 12, the remarks below will also address the Augenbraun and Schlack references, both of which were used with respect to the rejection of now cancelled claims 9 and 18.

Since neither Iggulden nor Mabon were expressly identified as pertaining to the limitations in now cancelled claims 9 and 18, it is understood that they lack any teaching or suggestion of these limitations now included in claims 3 and 12, respectively. Moreover, since no teaching from Iggulden or Mabon was applied to the limitations of claims 9 and 18 – now present in claims 3 and 12, respectively – it is submitted that a prima facie case of obviousness with respect to these references has not been established.

It has been admitted in the present Office Action that Plotnick and Rosenberg do not teach the limitations formerly in claims 9 and 18 and now in claims 3 and 12, respectively. *See Office Action at page 8.* Only Augenbraun and Schlack have been applied against the limitations now present by the current amendment in claims 3 and 12.

None of the references teach the use of a go-back function to switch between modes as defined in the claims. Specifically, the independent claims call for a capability to switch from the television program mode (currently active) to the interactive application mode (as the last viewed item). Instead, the Mabon and Plotnick references both teach that switching to a last viewed item from a currently viewed item occurs within the same mode. In Plotnick at paragraphs [0027]-[0031], it is clear that the teachings are expressly directed to shifting focus to

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any one of the application programs 34, 36, or 38 or to a default application program selected from application programs 34, 36, or 38. Plotnick does not switch focus to a television mode from his application mode or vice versa. Mabon is substantially similar in a functional way to Plotnick in that Mabon allows the user to dwell on a certain channel within a television program mode, which channel is known as a channel of interest, in order to permit the user to jump back to that channel at a later time. Mabon and Plotnick do not suggest that their focus shifting or jumping back functions can be used to cross between modes. They teach clearly that the focus shifting and jumping back are accomplished within a single mode. Thus, Mabon and Plotnick do not teach, show, or suggest the limitations of independent base claims 3 and 12. Rosenberg, Iggulden, Augenbraun, and Schlack do nothing to cure this defect in the teachings of Plotnick and Mabon. Thus, the combination of Plotnick, Rosenberg, Mabon, Iggulden, Augenbraun, and Schlack does not teach, show, or suggest the limitations of independent base claims 3 and 12.

Contrary to the interpretation given in this Office Action, Augenbraun minimizes the interruption of television program viewing by switching away from the program to the channel designated by the selected hyperlink when that channel has become available at the front of the carousel. At that time, the switch is made away from the viewed television program to the hyperlinked channel so that the download can progress on the display for the viewer. *See Augenbraun at paragraphs [0011] and [0034].* The download is completed in Augenbraun while the television program is interrupted. Thus, Augenbraun clearly shows that the user is unable to watch any television programming during downloading when downloading of hyperlinked content is requested by a user. This is exactly opposite to the invention defined in Applicants' claims.

It should be understood that the user in Augenbraun selects the hyperlink from a television channel, not from an interactive application mode different from the television program mode. When the hyperlinked information is downloaded, it comes to the user in a television channel slot identified as containing the information. There is no switching from one mode to another mode. In Augenbraun, the user always remains in the television program mode.

In contrast to Augenbraun, the claimed invention states that "when the browser mode is active, upon a download above a threshold time being detected" the television program mode is activated until the detection of completion of the download. Augenbraun never resides in a

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browser mode. The hyperlink is selected in a television mode and the viewed program in that television mode continues to be watch until the channel corresponding to the selected hyperlink is available in the carousel. When the hyperlink channel is at the head of the carousel and ready to be downloaded for viewing by the user, the television programming is interrupted and the channel is switched to the hyperlinked channel so that downloading can be completed. *Clearly,* Augenbraun teaches just the opposite of the claimed limitations since the user in Augenbraun is not permitted to watch the interrupted television program until the download is complete. The claims require that the television program mode be activated for viewing while the download is being completed. Thus, Augenbraun in combination with Plotnick, Mabon, Rosenberg, and Iggulden fails to teach, show, or suggest all the elements of claims 3 and 12.

Schlack does not cure any of the defects mentioned above with respect to the teachings of Plotnick, Mabon, Rosenberg, Iggulden, and Augenbraun as applied to the independent claims as amended. Schlack is not suggestive of download times related to a threshold. While Schlack does discuss a threshold, it is not used, defined, or suggested for use with respect to a measurement of a download time. Instead, Schlack uses the threshold to measure a length of time since the user's last channel change. If the user stays on the same channel for more than a certain period of time, then Schlack provides advertising to the user that is related to the viewed channel. Otherwise, if the channel change occurs over a shorter period of time, Schlack determines a change in advertising based on statistics maintained for the rapid channel changing. This has nothing to do with download times. Thus, Schlack does not teach all the limitations of claims 3 and 12. Moreover, Schlack in combination with Plotnick, Mabon, Rosenberg, Augenbraun, and Iggulden fails to teach, show, or suggest all the elements of claims 3 and 12.

In light of the remarks above, it is submitted that the combination of Plotnick, Rosenberg, Mabon, Iggulden, Augenbraun, and Schlack fails to teach all the elements of claims 3 and 12 and the claims dependent thereon. It is believed that the elements of these claims would not have been obvious to a person of ordinary skill in the art upon a reading of Plotnick, Rosenberg, Mabon, Iggulden, Augenbraun, and Schlack, either separately or in combination. Thus, it is submitted that claims 3-5 and 12-14 are allowable under 35 U.S.C. §103. Withdrawal of this rejection is respectfully requested.

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Rejection of Claims 6, 7, 15, and 16 under 35 U.S.C. §103

Claims 6, 7, 15, and 16 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg, and further in view of Mabon, and further in view of Iggulden, and further in view of Miller, and further in view of Zigmond. Since these claims have been cancelled, this rejection is believed to be moot.

Rejection of Claims 9 and 18 under 35 U.S.C. §103

Claims 9 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg and further in view of Mabon, and further in view of Iggulden, and further in view of Augenbraun, and further in view of Schlack. Since claims 9 and 18 have been cancelled without prejudice, this rejection is believed to be moot.

Rejection of Claims 19-21 under 35 U.S.C. §103

Claims 19-21 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg and further in view of Mabon, and further in view of Iggulden, and further in view of Plotnick II. This rejection is respectfully traversed.

Independent claim 19 includes limitations relating to downloading and switching modes while the download is in progress similar to those found in claims 3 and 12, as discussed above. The remarks presented above with respect to claims 3 and 12 will be understood to apply equally herein without further repetition. From those earlier remarks, it is clear that none of the applied references to Plotnick, Rosenberg, Mabon, and Iggulden even hint at the limitations for downloading and mode switching while a download is in progress. Thus, the combination of Plotnick, Rosenberg, Mabon, and Iggulden also fail to teach, show, or suggest these latter limitations of claim 19.

Plotnick II does not remedy the defects in the teachings of Plotnick, Rosenberg, Mabon, and Iggulden, as discussed above. Plotnick II briefly mentions that advertising opportunities exist when users are changing channels or retrieving information from a hard disk or a server. There is no mention or suggestion that there are two different operating modes and that the mode switching will be switched from an interactive application mode to a television program mode while a download is being completed. As such, the combination of Plotnick II with Plotnick,

Rosenberg, Mabon, and Iggulden does not teach, show, or suggest all the limitations of claim 19 and the claims dependent thereon.

In light of the remarks above, it is submitted that the combination of Plotnick, Mabon, Rosenberg, Iggulden, and Plotnick II fails to teach all the elements of the amended independent claims 19-21. It is believed that the elements of these claims would not have been obvious to a person of ordinary skill in the art upon a reading of Plotnick, Mabon, Rosenberg, Iggulden, and Plotnick II, either separately or in combination. Thus, it is submitted that claims 19-21 are allowable under 35 U.S.C. §103. Withdrawal of this rejection is respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that all the claims pending in this patent application are in condition for allowance. Entry of this amendment, reconsideration, and allowance of all the claims are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner contact the Applicant's attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled for resolving such issues as expeditiously as possible.

Please charge the $130.00 fee for the One Month Extension, and any other costs that may be due, and/or credit any overpayments, to Deposit Account No. 07-0832.

Respectfully submitted,
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